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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,039	04/18/2001	William Whitehead	85939.000189	9206

23387 7590 07/18/2002

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EXAMINER
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STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 07/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/837,039

Applicant(s)

WHITEHEAD, WILLIAM

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/25/02, 2/1/02, 2/20/02 and 5/7/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-17, 20-23 and 42-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-17, 20-23 and 42-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I      Figures 2-5

Group II      Figures 14-25

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, 6-8, 13-17 and 21-23 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

During a telephone conversation with Brian B. Shaw on October 26, 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 4, 5 and 26-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-12, 18, 19, 24, 25, 33-36 and 38-41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

The drawings are objected to because the applicant has failed to use the proper cross sectional shading when showing the invention in cross section. For example, see figure 2 wherein the applicant has failed to use the proper cross sectional shading for the body 20 or the sealing portion 40. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because recitations such as "is disclosed" on lines 2-3 can be easily implied and, therefore, deleted. On line 1, "an interface" is confusing since it is unclear what comprises "an interface". On line 3, it is suggested that the applicant insert --a-- following "includes" to avoid confusion. On lines 5-6, "a non zero . . . dimension" is confusing since it is unclear what the applicant is attempting to set forth. What two surfaces define the angle the applicant is referring to? How can the angle be defined with respect to a dimension when the dimension is nothing more than a length.

Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

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Claims 1-9, 13-17, 20-23, 42-54 and 65-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "a first and a second confronting surfaces" on lines 1-2 of claim 1 render the claims indefinite because they are grammatically awkward and confusing. Recitations such as "selected to emit light" on line 4 of claim 13 renders the claims indefinite because it is unclear what the applicant is attempting to set forth. Does the fiber optic light line actually emit light or is it merely selected in the hope that it can emit light? Recitations such as "the cross sectional area" on line 4 of claim 20 render the claims indefinite because it is unclear if the applicant is referring to the cross sectional dimension set forth above or is attempting to set forth another cross sectional dimension in addition to the one set forth above.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-9, 13-15, 17, 20-23, 42-44, 47-57, 60-63, 65-67 and 70-74 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Publication No. 198 41 180. German Patent Publication No. 198 41 180 discloses a weatherseal comprising an elongate polymeric body 1 including a sealing portion 4, a seating

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channel 8 extending along a longitudinal dimension of the polymeric body and a light generating line 9 disposed in the seating channel for generating and emitting light.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 5, 13, 16, 42, 44-46, 55, 57-59, 65 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 198 41 180 as applied to claims 1-3, 6-9, 13-15, 17, 20-23, 42-44, 47-57, 60-63, 65-67 and 70-74 above, and further in view of Laughman et al. Laughman et al. discloses a weatherseal 10 having a metallic reinforcing member 30.

It would have been obvious to one of ordinary skill in the art to provide the weatherseal of Laughman et al. with at least one light emitting line, as taught by German Patent Publication No. 198 41 180, to illuminate the vehicle opening when entering or exiting the vehicle.

Claims 64, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 198 41 180 as applied to claims 1-3, 6-9, 13-15, 17, 20-23, 42-44, 47-57, 60-63, 65-67 and 70-74 above. German Patent Publication No. 198 41 180 is silent concerning the distance the light generating light extends.

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However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to manufacture the seal with the light generating line extending along less than the entire length of the polymeric body.

### ***Response to Arguments***

Applicant's arguments filed January 25, 2002 have been fully considered but they are moot in view of the new grounds of rejection.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. International Patent Publication No. WO 97/07350 is cited for disclosing a fiber optic cable disposed within a seal. Plastics News and Automotive Components Analyst are cited for disclosing the use of side emitting fiber optic cables in various environments.

### ***Conclusion***

**THIS ACTION IS NOT MADE FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-



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305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a stylized flourish extending from the end.

Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
July 15, 2002